REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-18 are presently pending in this case.

In the outstanding Official Action, Claims 1-4, 7-10, and 11-18 were rejected under 35 U.S.C. §101; Claims 1-3, 5-7, 11-13, and 15 were rejected under 35 U.S.C. §102(b) as anticipated by Odamura (U.K. Patent Application Publication No. 2 360 912); and Claims 4, 8-10, 14, and 16-18 were rejected under 35 U.S.C. §103(a) as unpatentable over Odamura in view of Negishi et al. (U.S. Patent No. 6,504,089, hereinafter "Negishi").

With regard to the rejection of Claims 1-4 and 6 under 35 U.S.C. §101, it is respectfully submitted that Claim 1 (and Claims 2-4 and 7-10 dependent therefrom) includes the physical elements of "a database," "search means," "control means," and "a display." Claim 11 includes the physical elements of "a database," "a search unit," "a control unit," and "a display." Thus, Claims 1-4 and 7-18 clearly recite machines. With regard to the assertion in the outstanding Office Action that "a display can be created in software form,"[1] it is respectfully submitted that a display is a physical element and cannot be "created with software." To facilitate appeal, if the present rejection is maintained, it is respectfully requested that an Advisory Action provide an explanation as to how a display can be "created in software form."

Accordingly, Claims 1-4 and 7-18 are believed to be in compliance with all requirements under 35 U.S.C. §101.

With regard to the rejection of Claims 1, 5, 6, and 11 as anticipated by Odamura, that rejection is respectfully traversed.

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[1] See the outstanding Office Action at page 9, line 1.

Claim 1 recites in part:

> a database storing a plurality of text data with at least a first length;
> search means for searching the database for at least one piece of text data with the first length, based on an input search key;
> a display including a display area configured to display text data from the database, the display area having a width; and
> control means for obtaining partial text data with a second length that is smaller than the first length and corresponding to the width of the display area, out of the at least one piece of text data found by the search means, from the database, and to *display the partial text data on the display area*.

Odamura describes a client terminal 204 that downloads web pages from a server over the Internet for display on a display of a terminal 204. If a webpage is too tall long to display on the display of the terminal, the client terminal breaks up the webpage vertically into multiple pages.[2] The outstanding Office Action cited the client terminal 204 breaking up a webpage into multiple pages of Odamura as "control means" as recited in Claim 1.[3] However, it is respectfully submitted that a device for breaking up a webpage in the *vertical* direction (and *not* the horizontal direction) into multiple web pages as described by Odamura at page 10, lines 13-19 does not teach any means for *obtaining partial text data* with a *second length that is smaller than the first length* and corresponding to a *width* of a display area, out of the at least one piece of text data found by the search means, from the database, and to *display the partial text data on the display area* as recited in Claim 1.

In fact, Odamura does not describe truncating data based on the width of the display, only the height. The outstanding Office Action further asserted that page 7, lines 20-27 of Odamura teach that the range of the display is defined, and thus Odamura inherently teaches that the width could be beyond the displayed length on the page, thus requiring scrolling to

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[2] See Odamura, page 23, line 2 to page 24, line 3 and Figures 8-11.
[3] See the outstanding Office Action at page 4, lines 5-10.

access the end of the text. "In that case, display would be truncation by the page and not the height."[4] However, the fact that a certain result or characteristic <u>may</u> occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). (Emphasis in original). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic <u>necessarily</u> flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). (Emphasis in original). See MPEP §2112. In the present case, it is respectfully submitted that no evidence or reasoning has been provided to show that the device of <u>Odamura</u> *necessarily* includes all of the features recited in Claim 1.

In fact, <u>Odamura</u> only describes the vertical division of a webpage into multiple pages. No provision at all is discussed for webpages that are wider than display. Thus, these webpages *may* fit on the display, or <u>Odamura</u> would have addressed this problem. Accordingly, it is respectfully submitted that <u>Odamura</u> clearly does not *necessarily* include "control means" as defined in Claim 1.

For the purpose of facilitating appeal, if the present rejection is maintained, it is respectfully requested that Advisory Action provide evidence or reasoning that shows <u>Odamura</u> *necessarily* includes all of the features recited in Claim 1.

Thus, it is respectfully submitted that <u>Odamura</u> does not teach, either explicitly or inherently, "control means" as defined in Claim 1. Consequently, Claim 1 (and Claims 2-4 and 7-10 dependent therefrom) is not anticipated by <u>Odamura</u> and is patentable thereover.

Moreover, Claims 2 and 3 recite subject matter that further defines over <u>Odamura</u>. Claim 2 recites in part "instruction means for issuing an instruction for *horizontal scroll*

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[4]See the outstanding Office Action at page 9, lines 11-14.

display of the partial text data being displayed on the display area, wherein the control means controls to obtain remaining text data other than the partial text data from the database and to perform the horizontal scroll display on the display area, in response to the instruction." Claim 3 recites in part "the control means obtains a text data part, that is larger than the second length and smaller than the first length, out of the at least one piece of text data found by the search means, with the text data part added to the partial text data, from the database, and to *perform horizontal scroll* display on the display area."

It is respectfully submitted that no portion of Odamura describes *horizontal scrolling* of any kind. The outstanding Office Action cited page 12, lines 4-21 as describing this subject matter. However, this portion of Odamura merely describes editing retrieved webpages based on the capacity which a client terminal can display data. This process is clearly described at page 23, line 2 to page 24, line 3, where a page that is vertically too long for screen is divided into three pages. Again, no *horizontal scrolling* of any kind is described. Accordingly, Claims 2 and 3 further define over Odamura.

Claims 5 and 6 recite in part "obtaining partial text data with a second length that is smaller than the first length and corresponding to a width of a display area, out of the at least one piece of text data found in the searching, from the database, and to display the partial text data on the display area." As noted above, Odamura only describes a device for breaking up a webpage in the *vertical* direction into multiple web pages. As Odamura does not teach *obtaining partial text data* with a *second length that is smaller than the first length* and corresponding to a *width* of a display area and displaying *the partial text data on the display area*, Odamura does not teach, either explicitly or inherently, "obtaining partial text data" as defined in Claims 5 and 6. Consequently, Claims 5 and 6 are not anticipated by Odamura and are patentable thereover.

Claim 11 recites in part:

> a database configured to store a plurality of text data with at least a first length;
> a search unit configured to search the database for at least one piece of text data with the first length based on an input search key; and
> a control unit configured to obtain partial text data with a second length that is smaller than the first length and corresponding to a width of a display, out of the at least one piece of text data found by the search unit, from the database, and to display the partial text data on the display.

As noted above, Odamura does not teach any device configured to *obtain partial text data* with a *second length that is smaller than the first length* and corresponding to a *width* of a display and to *display the partial text data on the display* as recited in Claim 11. Thus, it is respectfully submitted that Odamura does not teach, either explicitly or inherently, "a control unit" as defined in Claim 11. Consequently, Claim 11 (and Claims 12-18 dependent therefrom) is not anticipated by Odamura and is patentable thereover.

Moreover, Claims 12 and 13 recite subject matter that further defines over Odamura. Claim 12 recites in part "an instruction unit configured to issue an instruction for *horizontal scroll* display of the partial text data being displayed on the display area, wherein the control unit is configured to obtain remaining text data other than the partial text data from the database and to *perform the horizontal scroll* display on the display area, in response to the instruction." Claim 13 recites in part "the control unit is configured to obtain a text data part, that is larger than the second length and smaller than the first length, out of the at least one piece of text data found by the search unit, with the text data part added to the partial text data, from the database, and to *perform horizontal scroll* display on the display area." As noted above with respect to Claims 2 and 3, no portion of Odamura describes *horizontal scrolling* of any kind. Therefore, Claims 12 and 13 further patentably define over Odamura.

With regard to the rejection of Claims 4, 8-10, 14, and 16-18 as unpatentable over Odamura in view of Negishi, it is noted that Claims 4, 8-10, 14, and 16-18 are dependent
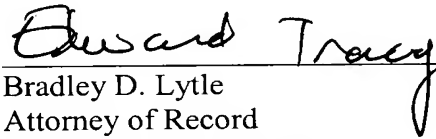
from Claims 1 and 11, and thus are believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that <u>Negishi</u> does not cure any of the above-noted deficiencies of <u>Odamura</u>. Accordingly, it is respectfully submitted that Claims 4, 8-10, 14, and 16-18 are patentable over <u>Odamura</u> in view of <u>Negishi</u>.

Accordingly, the pending claims are believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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